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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,650	06/20/2001	Matthew John Bending	67097-004	4180
27128	7590	12/06/2005	EXAMINER	
BLACKWELL SANDERS PEPER MARTIN LLP			BEKERMANN, MICHAEL	
720 OLIVE STREET			ART UNIT	
SUITE 2400			PAPER NUMBER	
ST. LOUIS, MO 63101			3622	

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,650

Applicant(s)

BENDING, MATTHEW JOHN

Examiner

Michael Bekerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-11.15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-11.15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/20/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to papers filled on 10/26/2005.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 2, 6-11, 15, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eller (U.S. Pub. No. 2002/0116717) in view of Unold (U.S. Pub. No. 2002/0055880).**

Referring to claims 1 and 10, Eller teaches a method and system for the rental of advertising space in facilities (the billboard can be located indoors)(Paragraph 0022, Sentence 3) that comprises: providing an information system which comprises a database that contains stored data upon a plurality of facilities which have space available for advertising and promotional purposes (Paragraph 0025, Sentence 2); allowing access to the database by users so that they may review the stored data (Paragraph 0025, Sentence 1) and select at least one facility where they wish to use the available advertising space (Paragraph 0026, Sentence 1); and providing a booking capability on the system such that the advertising space at the at least one facility may be booked by the user (Paragraph 0027, Sentence 1). The use of computers and servers (Paragraphs 0004 and 0005) to perform these steps is sufficient in describing a

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memory device storing a program and a processor in communication with said memory, as stated in claim 10. Applicant argues that Eller doesn't teach the providing of a search engine that is adapted to search the stored data in response to search parameters inputted by the user. In figure 3 of Eller, step 302 teaches the ability to list all billboards worldwide. Unold teaches a search engine capable of searching for an appropriate electronic advertising display that meets parameters input into the system by an advertiser (Paragraph 0136). It would have been obvious to one having ordinary skill in the art at the time the invention was made to implement Unold's search engine before providing Eller's list of rentable advertising displays. This way, advertisers wouldn't have to look through a list of millions of billboards worldwide, and they can just focus on the ones that meet their specific criteria.

Referring to claims 2 and 11, Eller teaches the step of providing an introduction capability on the system such that the user and the owner of the at least one selected facility may be put in contact with one another (Paragraph 0025, Sentence 2). The providing of a facility location satisfies the introduction capability required in these claims.

Regarding claims 6 and 18, Eller teaches the advertiser of the billboard system as having secure access to the server, but facility owner access is not specified. Unold teaches site owners as having separate access to the billboard system than that of advertisers (Abstract, Sentence 2). The system of Unold is taken to be an intranet. Also, since the access that advertisers have to Eller's system is secure, it would have been obvious to secure facility owner access as well. It would have been obvious to

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one having ordinary skill in the art at the time the invention was made to give facility owners of Eller's system secure intranet access to the system. This would allow facility owners to control pricing and content of their individual billboards.

Referring to claims 7 and 15, Eller teaches the stored data as being geographical location (Paragraph 0025, Sentence 2)

Referring to claims 8 and 16, Eller teaches the user accessing the system via the internet (Paragraph 0025, Sentence 2).

Regarding claims 9 and 19, Eller specifies a store as a possible billboard facility (Paragraph 0022, Sentence 3). Eller doesn't specifically teach the electronic billboards as being located within a shopping mall. Examiner takes a mall to merely require a group of individual stores in close proximity to one another. It would have been obvious to one having ordinary skill in the art at the time the invention was made to not discriminate against any store by placing the invention of Eller, not only within a freestanding store, but also within a store that happens to be located within a shopping mall. This would allow mall stores, as well as freestanding stores, to receive added revenue from electronic billboards.

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eller (U.S. Pub. No. 2002/0116717) in view of Unold (U.S. Pub. No. 2002/0055880), and further in view of Thomson (U.S. Pub. No. 2003/0061104).

Neither Eller nor Unold teach a system comprising a telephone help center. Thomson teaches an internet-based ordering system that provides a toll-free telephone number to an expert call center (Paragraph 0091). It would have been obvious to one

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having ordinary skill in the art at the time the invention was made to include such a telephone help center in Eller's system. This would allow for improved customer service should complications arise in the booking process.

Response to Arguments

5. In response to the 102(e) rejection for claims 1 and 10, this rejection has been withdrawn in light of applicant's amendment. As explained above, however, the Eller reference mentions the ability to display billboards in a list format. Examiner provides motivation to combine the search engine of Unold with the system of Eller in the rejection.

6. In response to the 103(a) rejection for claims 9 and 19, applicant argues that there is no motivation to modify a facility of Eller to make it into a shopping mall. This was not the Examiner's original argument, and more detail has been added to the rejection above to clarify what the examiner originally intended.

7. In response to the 103(a) rejection for claim 17, applicant argues that Thompson does not provide reasoning for a call center to be included into the system of Eller. As described above, both Thompson and Eller describe businesses for placing an order over the Internet. Therefore, the same reason Thompson benefits from a call center can be applied to the system of Eller (better customer support should problems arise).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JEFFREY D. CARLSON
PRIMARY EXAMINER

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